



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

g²

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/693,667 | 10/24/2003 | Jeffrey Dean Black | 5598/28Cont. | 9634 |

7590 05/05/2006

Steven S. Rubin
Brown Raysman Millstein Felder & Steiner LLP
900 Third Avenue
New York, NY 10022

EXAMINER

CHEN, TE Y

ART UNIT PAPER NUMBER

2161

DATE MAILED: 05/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/693,667 | Applicant(s) BLACK ET AL. | |
| | Examiner Susan Y. Chen | Art Unit 2161 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-21 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 4-21 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 24 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>10/1/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 4-21 are presented for examination.

Priority

Applicant's claim for the benefit of a prior-filed application No. 09/374,175 (now U.S. Patent No. 6,654,813) on Aug. 13, 1999, that claimed a provisional application no. 60/097,029, filed on Aug. 17, 1998 which under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

Information Disclosure Statement

The information disclosure statement filed on Oct. 01, 2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been totally considered, specifically for the listed prior arts: WO 97/15018 and WO 97/29414, because there is no copy for these two documents.

Specification

The disclosure is objected to because of the following informalities:

Objection 1:

Art Unit: 2161

The disclosure is objected to because it contains a lot of embedded hyperlink and/or other form of browser-executable code [e.g., Page 2, line 7, Page 3, line 2, Page 5, line 9, etc.]. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Objection 2:

The use of the trademark "EDGAR" has been noted in this application. Although the instant application capitalized wherever it appears, however, it fails to accompany by the generic terminology for this trademark.

Although the used of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 9, the claimed subject matter "EDGAR" is a trademark of EDGAR Online, Inc. Because the trademark or trade name is used in a claim as a limitation to

Art Unit: 2161

identify or describe a particular material or product, thus, the claim does not comply with the requirements of the 35 U.S.C. 112, second paragraph. Ex parte Simpson, 218 USPQ 1020 (Bd. App. 1982).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 14 is rejected under the judicially created doctrine of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,654,813 as well as claims 1 and 12 of U.S. Patent No. 6,735,585. Although the conflicting claims are not identical, they are not patentably distinct from each other. To facilitate the comparing of these two claims, the recitation of these claims are listed as following:

| Instant Application | U.S. Patent No. '813 | U.S. Patent No. '585 |
|---|---|--|
| <p>Claim 14:</p> <p>A method for providing a user with at least one response to a search query of the Internet, the method comprising:</p> <p>receiving a search query from a user in the form of category selection;</p> <p>determining at least one entity associated with the search query;</p> <p>determining at least one URL under the control of the entity; and</p> | <p>Claim 1:</p> <p>A method of operating a search engine, comprising:</p> <p>acquiring from a user of the search engine a search request, the search request including a set of criteria that defines a category of entities;</p> <p>dynamically applying the set of criteria to identify an entity that meets the criteria;</p> <p>determining that the entity is registered as having control over at least a portion of a World-Wide</p> | <p>Claim 1:</p> <p>A method for performing a World-Wide Web search, comprising:</p> <p>acquiring from a user a search request containing search criteria;</p> <p>performing a conventional search based on said search criteria to obtain conventional search results containing at least one Web address of a located Web page;</p> <p>determining at least one</p> |

| | | |
|------------------------------------|--|--|
| | Web address; and associating the at least a portion of a World-Wide Web address with the entity | entity that is registered as having control over at least a portion of said located Web page; and generating supplemented search results based on said conventional search results, said at least one entity, and said search criteria; said supplemented search results including information not included in said conventional search results, where such information includes entity information, other than contact information, associated with said at least one entity. |
| displaying the URL to the user. | in a presentation to a user of the search engine that | Claim 12: The method of claim 1, further comprising |

| | | |
|--|---|---|
| | identifies the entity and indicates that the entity belongs to the category of entities. | presenting said supplemented search results to said user. |
|--|---|---|

Because claim 1 of U.S. Patent No. '813 as well as claims 1 and 12 of U.S. Patent No. '585 contain every element of claim 1 of the instant application and thus anticipates the claim of instant application. Claim 1 of the instant application therefore is not patently distinct from the earlier patented claims and as such is unpatentable over obvious-type double patenting. A later patent/application claim is not patentably distinct from earlier claims if the later claim is anticipated by the at least one of earlier claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 2161

Claims 4, 6, 8, 10-11, 13-14 and 16-21, are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,958,008 issued to Pogrebisky et al. (hereinafter referred as Pogrebisky).

Claim 4:

Pogrebisky discloses a system for providing a user with at least one response to a search query of the Internet [e.g., Abstract, the Astra system as shown in Fig(s) 1, 19-20, etc.], the system comprising:

a user interface, the user interface effective to receive a search query from a user [e.g., col. 2, lines 18-23];

a web page record database connected to the user interface, the web page record database including a plurality of records, the plurality of records including a response to the search query [e.g., col. 3, lines 31-43];

a search engine module connected to both the user interface and the web page record database, the search engine module effective to search the web page record database for the response [e.g., the use of Webcrawling, Common Gateway Interface and Internet/Intranet techniques at col. 7, lines 9 –16 & 23-31& Fig(s) 7, 13-15];

an entity information database including information about entities [e.g., the Web site, database, col. 5, lines 66 – col. 6, line 16]; and

a mapping database connected to the web page record database and the entity information database, the mapping database including information for mapping the

Art Unit: 2161

records with respective entities [e.g., the Web site map, col. 7, lines 54–67; Fig. 1 and associated texts].

Claim 6:

Except the limitations recited in claim 4, Pogrebisky further discloses that the entity information database includes geographic information about the entities [e.g., Abstract, lines 4-6; Fig. 4 and associated texts].

Claim 8:

Except the limitations recited in claim 4, Pogrebisky further discloses that the mapping database maps a particular entity to a plurality of records.

Claim 10:

Pogrebisky discloses a method for providing a user at least one response to a search query of the Internet [e.g., Fig. 1 and associated texts], the method comprising: receiving a search query from a user [e.g., col. 2, lines 18-23];

searching a web page record database for a response to the search query [e.g., e.g., the use of Webcrawling at col. 7, lines 9-16; Fig(s) 13-15];

mapping the response to an entity associated with the response [e.g., the Web site map, col. 7, lines 54–67; Fig(s). 1-3 and associated texts]; and

displaying the response and a name of the entity to the user [col. 15, lines 27-44; Fig.(s) 1 and 4-6].

Claim 11:

Except the limitations recited in claim 10, Pogrebisky further discloses that the search query is based on a hierarchical category structure [e.g. col. 2, lines 27-48; Fig. 6].

Claim 13:

Except the limitations recited in claim 10, Pogrebisky further discloses that the method comprising displaying geographic information about the entity [e.g., Abstract, lines 4-6; Fig. 4 and associated texts].

Claim 14:

Pogrebisky discloses a method for providing a user with at least one response to a search query of the Internet [e.g., Abstract, Fig. 1], the method comprising:
receiving a search query from a user in the form of category selection [e.g., the use of user interface at col. 2, lines 18-23];

determining at least one entity associated with the search query [the use of Web site map, col. 7, lines 54-67; Fig. 1 and associated texts];

determining at least one URL under the control of the entity [e.g., the use of URL technique at col. 10, lines 7-30 and Fig. 3];

displaying the URL to the user [e.g., the use of Visual Web Display technique at col. 10, lines 54-57; Fig(s) 1-3].

Claim 16:

Except the limitations recited in claim 14, Pogrebisky further discloses that the category selection comes from a hierarchical category structure [e.g. col. 2, lines 27-48; Fig. 6].

Claim 17:

Except the limitations recited in claim 14, Pogrebisky further discloses that the search query includes geographic criteria and the method further comprises filtering the at least one URL based on the geographic criteria before performing the displaying [e.g., the filtering bar (47, Fig. 1) at col. 16, line 8-26 & col. 26, VIII section].

Claim 18:

Except the limitations recited in claim 14, Pogrebisky further discloses that the geographic criteria is a city [e.g., col. 19, lines 29-33].

Claim 19:

Except the limitations recited in claim 14, Pogrebisky further discloses the at least one URL includes a plurality of URLs and the plurality of URLs are displayed to the user in an order of popularity [col. 3, lines 9-30].

Claim 20:

Art Unit: 2161

Except the limitations recited in claim 14, Pogrebisky further discloses displaying a name of the entity [e.g., Fig. 4 and associated texts].

Claim 21:

Except the limitations recited in claim 14, Pogrebisky further discloses displaying a plurality of URLs and the method further comprises enabling the user to execute a search in only the plurality of URLs [e.g., the use of clicks on URL icon, at col. 10, lines 20-30 and Fig. 3].

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 2161

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 7, 9, 12 and 15, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,958,008 issued to Pogrebisky et al. in view of Applicant Admitted Prior Art (AAPA).

Claim 5:

Except the limitations recited in claim 4, Pogrebisky does not specifically disclose that the mapping database uses American Business Information Numbers.

However, as admitted by Applicant's specification that the American Business Information Numbers is sponsored by info USA [e.g., Page 6, line 3], thus, it would have been obvious for an ordinary skilled person in the art at the time the invention was made to apply the widely used existing American Business Information Numbers into the claimed mapping database, because by doing so, the claimed database will be allowed to map the unique American Business Information Numbers to any American business without reinventing the wheel.

Claim 7:

Except the limitations recited in claim 4, Pogrebisky does not specifically disclose that the entity information database uses Standard Industry Code (SIC) fields.

However, as admitted by Applicant's specification that the claimed Industry Code is a Standard. Therefore, it would have been obvious for an ordinary skilled person in the art at the time the invention was made to apply the well-known SIC field in the claimed

Art Unit: 2161

database, because by doing so, the claimed database will be upgraded to apply the SIC field for classifying the industry and still binding to the desired standard.

Claim 9:

Except the limitations recited in claim 4, Pogrebisky does not specifically disclose that the entity information database includes information from EDGAR. However, as discussed in the above 35 U.S.C. 112 second paragraph rejection, EDGAR is the Trademark of EDGAR online, Inc., as such, it would have been obvious for an ordinary skilled person in the art at the time the invention was made to apply the well-known global business and financial EDGAR data into the claimed entity information database, because by doing so, the claimed entity database will be promoted to support the manipulation of global business and financial entities as needed.

Claim 12:

This claim recites similar subject matters as claim 5 in form of method, hence, is rejected for the same reason.

Claim 15:

This claim recites similar subject matters as claim 7 in form of method, hence, is rejected for the same reason.

Conclusion

To expedite the process of re-examination, the examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. 35 U.S.C. 112) set forth by the Examiner prior to the office action, that applicant should provide and link to the most specific page and line numbers of the disclosure where best support is found (see 35 U.S.C. 132).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

1) Teare et al. (U.S. Patent No. 6,151,624) which discloses a network resources navigating system using metadata locating the resources in a language-independent manner.

2) Weinberg et al. (U.S. Patent No. 5,974,572) which discloses a system provides a variety of features for generating a load test using a server access log.

Points of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Y. Chen whose telephone number is 571-272-4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susan Y Chen
Examiner
Art Unit 2161

April 20, 2006

